



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No: 09/593,914 Confirmation No: 8319
Date Filed: June 14, 2000
Application Title: Probes, Probe Sets, Methods And Kits Pertaining To The
Detection, Identification And/Or Enumeration Of Yeast;
Particularly In Wine
Applicants: Hyldig-Nielsen et al.
Group Art Unit: 1634
Examiner: C. Myers
Application Status: Appeal Brief Filed
Action Type: Reply To The "Decision On Petition" Dated March 3, 2004

Certificate of Transmission:
37 C.F.R. § 1.8

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office (Fax No. 703-872-9306) on this 27th day of April, 2004.

A handwritten signature in cursive script, appearing to read "Brian D. Gildea".

Brian D. Gildea
Reg. No. 39,995

Attention: Bruce Campell, Director, Technology Center, 1600: Total Pages Sent: 4

Petition Under 37 C.F.R. § 1.144 or § 1.181

Commissioner for Patents
Dear Sir or Madam:

Preliminary Statement

In the above captioned application, the Examiner issued a restriction requirement in Office Action paper No. 9 (Office Action dated July 18, 2001). Applicants did enter traverse of the restriction requirement as well as make appropriate argument and a request for reconsideration, in reply to said Office Action, by submission dated January 17, 2002. Applicants did timely file a petition under 37 C.F.R. § 1.144 requesting review of the Examiner's decision by paper dated August 22, 2003. Applicants received a Decision On Petition dated March 3, 2004 wherein the petition under 37 C.F.R. § 1.144 was DENIED.

relied upon to deny the petition, it is well accepted that the MPEP must comply with, and cannot overrule, case law.

Applicants hereby respectfully traverse the restriction requirement recited in Paper No. 9 (Office Action dated July 18, 2001) as being clearly contrary to the express holdings of both *In re Weber* and *In re Haas*. *In re Weber* expressly holds that:

It is apparent that § 121 provides the Commissioner with the authority to promulgate rules designed to Restrict an Application to one of several claimed inventions when those inventions are found to be “independent and distinct”. It does not, however, provide a basis to an examiner acting under the authority of the Commissioner to Reject a particular Claim on that same basis. *In re Weber*, 580 F.2d 455, 458, 198 U.S.P.Q. 328, __ (CCPA, 1978)

We hold that a rejection under § 121 violates the basic right of the applicant to claim his invention as he chooses (emphasis added). *In re Weber*, 580 F.2d 455, 459, 198 U.S.P.Q. 328, __ (CCPA, 1978)

A similar holding has been entered in *In re Haas*, 198 U.S.P.Q. 334.

Accordingly, it is clear from the precedent cited by The Office in the Office Action dated July 18, 2001 (*In re Weber*), the legal issue of whether or not The Office may impose a restriction requirement to a single claim has been decided against The Office. It is well settled that such a requirement violates 35 U.S.C. 121, where the applicant is statutorily entitled to claim his invention as he deems proper. This is true whether or not the inventions are determined by The Office to be independent and distinct. Accordingly, it is improper for the Examiner to demand that the claims be amended to redact all Seq. ID Nos., other than Seq. ID No. 1, from any of claims 10, 11, 21, 22, 34, 61 or 62.

Applicants further note that each Group that the Examiner argues is a separate invention (each distinct Seq. ID No. (e.g. 1-11)) is classified in Class 435, subclass 6 and Class 536, subclass 24.32. Thus, for purposes of a search, there is no additional burden

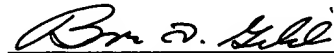
on The Office since the same class and subclasses must be searched, and no additional Class or subclass must be searched, whether or not a restriction requirement is imposed.

Additionally, Appellants take the position that said claims are generic and do not use improper Markush format. Accordingly, Appellants takes the position that the restriction requirement recited in paper No. 9 is improper. Reconsideration of the restriction requirement issued in the Office Action dated July 18, 2001 and affirmed by the Decision On Petition dated March 3, 2004 is hereby requested.

Fees

The Office is hereby authorized to deduct the required fee for consideration of this petition, believed to be \$ 130.00, from Deposit Account No. 02-3240.

Respectfully submitted
On behalf of Applicants,



Brian D. Gildea; Reg. No. 39,995

In response to said Decision On Petition, Applicants will submit a Supplemental Appeal Brief arguing that the issue of whether or not the restriction requirement was properly issued by the Examiner is now ripe for consideration for the Board of Appeals. In order to not waive any of Applicant's rights, this new Petition under 37 C.F.R. § 1.144 or § 1.181 is being filed. Applicants hereby petition for review of the Examiner's decision with regard to a restriction requirement as set forth in Office Action paper No. 9 as well as review of the Decision On Petition dated March 3, 2004.

Argument In Support Of Request To Withdraw Restriction Requirement

In the Office Action of Paper No. 9, the Examiner took the position that, with respect to claims 10, 11, 21, 22, 34, 61 and 62, Applicants presented claims in improper Markush format. The Examiner cited to *Ex parte Markush*, 1925 C.D. 126 and *In re Weber*, 198 U.S.P.Q. 334¹ as legal support for this position. The Examiner's argument also relied upon 35 U.S.C. § 121 as statutory support for the restriction requirement. Specifically the Examiner stated: "Restriction to one of the following inventions is **required under 35 U.S.C. 121:**" (See page 2 of the Office Action dated July 18, 2001. At page 4 of the Office Action dated July 18, 2001, the Examiner states: "These sequences are thus deemed to constitute independent and distinct inventions **within the meaning of 35 U.S.C. § 121.** Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, **subject to a restriction requirement pursuant to 35 U.S.C. § 121.**"

In the Decision On Petition dated March 3, 2004, the Discussion section states: "**The examiner has not set forth any rejection based upon 35 U.S.C. 121 in this application.**" Appellants respectfully submit that based upon review of the Office Action dated July 18, 2001, it is apparent that the sole statutory basis relied upon for issuance of the restriction requirement is 35 U.S.C § 121. Moreover, as discussed in detail below, such action has been considered by the courts to be improper. While it is noted that sections of the Manual of Patent Examining Procedure (MPEP) have been

¹ The proper citation to *In re Weber* is 580 F.2d 455, 198 U.S.P.Q. 328 (CCPA, 1978). Nevertheless, the case cited at 198 U.S.P.Q. 334 (*In re Haas*) does pertain to same question of law.

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APPLIED BIOSYSTEMS

BRIAN D. GILDEA
APPLIED BIOSYSTEMS
15 DEANGELO DRIVE
BEDFORD MA 01730In re application of Jens J. Hyldig-Nielsen et al.
Serial No. : 09/593,914
Filed : June 14, 2000
Attorney Docket No.: BP9901US

DECISION ON PETITION

This is in response to applicants' petition, filed August 25, 2003 under 37 CFR 1.144, to withdraw the restriction requirement set forth by the examiner.

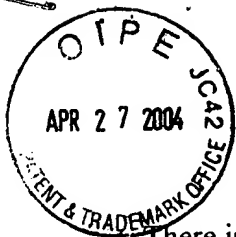
BACKGROUND

Review of the file history shows that the application was filed June 14, 2000 under 35 U.S.C. 111(a). The application as filed contained 85 claims. On January 15, 2002 the examiner mailed a first Office action on the merits, which included a restriction requirement requiring applicants to elect a single nucleotide sequence for examination. Applicants had elected (telephonically) SEQ ID No: 1. In response, the examiner withdrew claim 34 from consideration and limited examination of the remaining claims to the elected sequence. On February 19, 2002 applicants filed a response in which the restriction requirement was traversed on essentially the same grounds argued in the petition. On July 17, 2002 the examiner mailed an Office action in which the restriction requirement was made final. A final rejection was mailed February 25, 2003, and Applicants filed an appeal brief on February 18, 2004.

DISCUSSION

Applicants argue that it is improper to restrict a single claim into multiple inventions, citing *In re Weber*. This argument is not persuasive. In the *Weber* case, the Court ruled that it was improper for the examiner to reject claims under 35 U.S.C. 121. The examiner has not set forth any rejection based on 35 U.S.C. 121 in this application. Moreover, applicants have not provided any support for their position that an examiner may not find more than one distinct invention within a claim. MPEP 802.01 states, in part:

The law has long been established that dependent inventions (frequently termed related inventions)...may be properly divided if they are, in fact, "distinct" inventions, even though dependent....The term "distinct" means that two or more subjects as disclosed are related...but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and



unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art).

There is no requirement that the distinct inventions be claimed in separate claims for restriction practice to be applicable. Indeed, MPEP 803.04 provides examples wherein single claims claiming multiple nucleic acid sequences are subject to restriction.

Applicants argue that it would not be a burden to search all of the claimed sequences because they are all classified in the same class and subclass. This argument is not persuasive. Nucleic acid sequences are searched by comparing a sequence to those found in various public and proprietary databases. Unless there is a disclosed common structure shared by two or more sequences, it is impossible to simultaneously search for more than one sequence.

DECISION

Applicants' petition is **DENIED**.

Since no fee is required for this petition, \$130.00 will be refunded to deposit account 02-3240, as directed.

The application will be forwarded to the examiner for consideration of the appeal brief filed February 18, 2004.

Any request for reconsideration or review of this decision must be made by a renewed petition and must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely.

Should there be any questions with regard to this letter please contact Bruce Campell by letter addressed to the Director, Technology Center 1600, P.O. Box 1450, Alexandria, VA, 22313-1450, or by telephone at (571) 272-0974 or by facsimile transmission at (571) 273-0974.

John Doll
Director, Technology Center 1600